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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,153

01/14/2004

Robert J. Vermillion

16990.3

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24919

7590

12/31/2007

MCAFEE & TAFT

TENTH FLOOR, TWO LEADERSHIP SQUARE

211 NORTH ROBINSON

OKLAHOMA CITY, OK 73102

EXAMINER

FORTUNA, JOSE A

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

12/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/757,153	VERMILLION, ROBERT J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	José A. Fortuna	1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-21 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-21 and 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. The finality of that action is withdrawn in view of applicants' arguments and new ground of rejection, see below.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 9-21 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermillion, US Patent No. 5,637,377 or McAllister et al., US Patent No. 4,909,901 in view of Yasuda, US Patent No. 3,682,696 further evidenced by Armington et al., US Patent No. 4,806,410.

Vermillion teaches a corrugated contained including a middle wavelike layer **24**, sandwiched between two layers **28** and **30**, **see figures**. Vermillion teaches that the middle layer, the wavelike/corrugated layer contains no less than 7.5% of electrical conductive substances and

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the layers sandwiching the electrical conductive layer contain static dissipative substances, see column 4, lines 16-54. Note that Vermillion teaches that the electric conductive substance is carbon particles, preferably carbon black particles, see column 4, lines 20-33 and that the medium is preferably made of Kraft pulp. Note that Vermillion teaches the same conductive and dissipative properties as claimed in claims 10-11, see for example see column 4, lines 16-54 and column 5, lines 51-57 and paragraph bridging columns 3-4. The amount of sulfur of claim 20 is taught in column 4, lines 16-54 and in example 1, column 7. The basis weight of the conductive paperboard is within the claimed range, see column 5, lines 31-41.

McAllister et al. teach a multilayer fibrous material suitable for use as EMI and RFI shielding packaging material, see abstract. McAllister et al. teach that the fibrous material is composed of paper or paperboard first and second layers and an inner layer containing conductive carbon particles, see abstract. McAllister et al. teach that in order to render the outer layers antistatic or static dissipative, the layers are coated with a clay composition, i.e., uniformly distributed in the outer layers, column 2, lines 50-59. The conductivity of the dissipative layers and the conductive layer in the same claimed range is disclosed in column 3, lines 62-65.

Vermillion and McAllister et al. do not teach the homogeneously distribution of the static dissipative substance on the linerboard, just coating. However, Yasuda teaches the use of antistatic<sup>1</sup> substances that can be either coated on the linerboard or added to the pulp, i.e., homogeneously distributed in the board, column 1, lines 30-38 and column 1, 70 through column 2, line 59.. Therefore, the using the static dissipative substance homogeneously distributed in the linerboard of the primary references Vermillion or McAllister et al. would have been obvious to

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one of ordinary skill in the art in view of the teachings of Yasuda. Note that one of ordinary skill in the art would recognize that what is important it's not how the substances are added on the paper/board, but that the final properties of the paper/board, i.e. the dissipative and/or conductive properties of the paper/board and Yasuda teaches that the same properties could be obtained either by coating or homogenously mixing the substances with the pulp.

Yasuda teaches the same substances can be used to electrification preventive substances, i.e., anti-static agents, see column 1, lines 30-38 and column 1, 70 through column 2, line 59. Therefore, using the substances taught by Yasuda as the dissipative agents of the primary references would have been obvious to one of ordinary skill in the art, since he/she would have reasonable expectation of success if the compounds suggested by Yasuda were used for the intended purpose.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Fiberboard compositions."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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<sup>1</sup> Note that the terms "antistatic" and "static dissipative" have been used in the art as equivalent, see for example Armington et al., (abstract). Note that the ways to prevent static is actually dissipation of the static throughout the body, substance, web, etc.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/  
Primary Examiner  
Art Unit 1791

JAF